

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket: ATM-2360

Applicant : Joseph WITTEMER

Serial No. : 10/692,682

Filed : October 27, 2003

Title : PACKAGING BAG

**PETITION UNDER 37 CFR 5.25 FOR A RETROACTIVE LICENSE FOR
FOREIGN FILING**

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicant hereby petitions the Commissioner under 37 CFR 5.25 for a retroactive license for foreign filing of the subject matter in question.

A check in the amount of \$130.00 for the required petition fee under 37 CFR 1.17 (h) is enclosed. If any extra fees are required, please charge deposit Account #06-1110 (a duplicate of this page is enclosed).

The subject matter in question is embodied in the above-identified U.S. patent application.

The unlicensed patent application material (i.e., subject matter in question) was only followed in following foreign country (i.e., regional patent system):

<u>Country</u>	<u>Serial No.</u>	<u>Filing Date</u>	<u>Status</u>
Europe	02406095.6	12/12/2002	Pending

The declaration of Joseph Wittemer, Hans Burkhardt, Samuel Gernet, Esther von Rohr and Virgil H. Marsh are enclosed. The declarations contain an averment that the subject matter in question was not under a secrecy order at the

time abroad, and that it was not currently under a secrecy order, a showing that the license has been diligently sought after discovery of the proscribed foreign filing, and an explanation of why the material was filed abroad inadvertently through error and without any deceptive intent.

The five enclosed declarations contain detailed showings of the facts as to the nature of the error, Joseph Wittemer is the sole inventor of the subject matter of the U.S. and European patent applications.

The invention and the European application and the U.S. application have been assigned to Alcan Technology & Management Ltd. (AG). Hans Burkhart is a Swiss patent agent and head of the Intellectual Property (patent) department of Alcan Technology & Management Ltd. Samuel Gernet and Esther von Rohr are clerks employed in the Intellectual Property department of Alcan Technology & Management Ltd. Virgil H. Marsh (i.e., the undersigned attorney) is a registered patent attorney who is the attorney of record in this case.

Inventor Joseph Wittemer is a U.S. citizen and made his invention in the United States. At that time and up to the present time, his residence has been in Louisville, Kentucky. Mr. Wittemer is an engineer employed by Alcan Packaging at its Shelbyville, Kentucky facility.

Alcan Packaging and Alcan Technology & Management Ltd. are directly or indirectly subsidiaries or affiliates of Alcan, Inc., a corporation of Canada.

The Intellectual Property (Patent) department of Alcan Technology & Management Ltd. has a contract with Alcan Packaging to provide some of its facilities, i.e., substantially for ones located in Europe, with services in the field of

intellectual property. The Intellectual Property department of Alcan Technology & Management Ltd. (ATM) has responsibility for preparing and filing patent applications for inventions made by employees, consultants, etc., of the Shelbyville, KY facility of Alcan Packaging.

On September 5, 2002 Mr. Wittemer sent a request pursuant to the above-mentioned service contract to Intellectual Property department of ATM for a search for a specific packaging form that was possibly patented by a third party company. The search was conducted by the "Information-Center" of his Intellectual Property department (Patent department). The search did not reveal any third party property rights.

In the last week of September 2002 Mr. Wittemer in person visited the Patent Department of ATM at Neuhausen, Switzerland to propose a new idea to be patented. Again, based on the service contract, ATM's Patent Department took over. An outside patent counsel (not an employee of Alcan), located in Europe, drafted an application text in the German languages. An outside translation office translated the text into the English language. Mr. Wittemer agreed in general with the English text and added only one revision to it. The outside counsel picked-up the revision and inserted the revision into the German text and sent the text to ATM's office. From said outside counsel accompanying said text, the Patent Department office received the outside counsel's later dated December 11, 2002. Such letter said in the German language: "Enclosed find the ready-to-file text in the German language for priority filing and the respective English translation." [English language translation]

Ms. von Rohr is responsible for all priority patent application and filings and foreign patent application filings made by the Patent department. Following her routine, Ms. von Rohr prepared the formal papers for the European Patent Office (EPO) and filed the German language version of the specification ("ready-to file text in the German language for priority filing") in the European Patent Office (via the Swiss Patent Office) on December 12, 2002. Based on the recollection of Mr. Burkhart and Ms. von Rohr, because of the specification being in the German language and being very busy at the time with the accompanying stresses, Ms. von Rohr prepared the formal papers and signed them, and then Mr. Burkhart co-signed them, without Ms. von Rohr or Mr. Burkhart recognizing the problem involved. Subsequently, Ms. von Rohr sent the request and the specifications to the Swiss Patent Office, that handles European applications filed in Switzerland for the EPO.

Neither Mr. Burkhart nor Ms. von Rohr paid any attention after the filing of the EPO application because Ms. von Rohr was very busy with getting all her duties done a short time before the holiday season and Mr. Burkhart went on a four week vacation over the holiday season. The application number supplied by the EPO was subsequently docketed by another clerk, Samuel Gernet, who was not aware of the rules and regulations regarding U.S. inventors and filings in foreign countries.

Mr. Wittemer was routinely advised that the European patent had been filed on December 12, 2002.

The matter of filing Mr. Wittemer's invention first outside of the U.S. without a license for filing, only arose and came to the attention of Mr. Burkhart and Ms. von Rohr when Ms. von Rohr started the preparations for foreign filing and sending the order for the U.S.-filing to the office of Virgil H. Marsh, Esq., Fisher Christen & Sabol, Washington, D.C. on October 2, 2003. Mr. Burkhart immediately informed Mr. Marsh of the inadvertent foreign filing of Mr. Wittemer's invention in his October 2, 2003 letter to Mr. Marsh. Mr. Burkhart did not realize until that point in time that a license for foreign filing had been necessary to first file the European application. The filing first of the European application without first obtaining a license for foreign filing was inadvertent. The error of not first filing the application in the United States was inadvertent.

On October 7, 2003 Mr. Marsh's office received an order dated October 2, 2003, sent via air carrier by Mr. Burkhart to file a U.S. patent application by the one-year priority due date of December 12, 2003. Mr. Burkhart's order letter stated that the U.S. patent application was to be based on the original European Patent Application No. 02406095.6, filed on December 12, 2002. The order letter also stated that the sole inventor was Mr. Joseph Wittemer, a U.S. citizen, residing at 4202 Patterson Park Court, Louisville, KY 40299. The order letter of October 2, 2003 of Mr. Burkhart further stated: "Please note that unintentionally we've filed a European instead of a U.S. priority application. Please file a retroactive license."

Mr. Marsh sent an e-mail on October 12, 2003 to Mr. Burkhart stating that Mr. Marsh wanted to quickly file the U.S. application with the petition for a

retroactive license for foreign filing being filed shortly thereafter and asked permission to send a declaration and a copy of the application to Mr. Wittemer. On October 13, 2003 Mr. Marsh received an e-mail from Mr. Burkhart that Wittemer would be in Neuhausen, Switzerland facility the next day. On October 13, 2003 Mr. Marsh faxed the declaration to Mr. Burkhart to attach a copy of the application and secure execution by Mr. Wittemer. On October 14, 2003 Mr. Marsh received a fax message from Ms. von Rohr that executed declaration and attached application was being sent by air carrier. The executed declaration and attached application was delivered to Mr. Marsh's office on October 16, 2003 and apparently placed in the file wrapper. It was subsequently located there, and on October 23, 2003 Mr. Marsh sent an e-mail to Mr. Burkhart that the U.S. application was filed on October 27, 2003. On October 28, 2003 Mr. Marsh's office sent a report to Mr. Burkhart that the U.S. application had been filed.

On October 30, 2003 Mr. Marsh received an e-mail of that date from Ms. von Rohr inquiring about the petition. On the same date Mr. Marsh sent an e-mail to Ms. von Rohr that Mr. Marsh would send her office a letter requesting specific information so that the petition could be prepared. On November 11, 2003 Mr. Marsh faxed and mailed a letter to Mr. Burkhart that set out in detail the information Mr. Burkhart and other persons needed to supply him. On December 2, 2003 Mr. Marsh sent an e-mail reminder to Mr. Burkhart. On December 3, 2003 Mr. Burkhart sent to Mr. Marsh an e-mail that set out in detail the facts and sequence of events regarding the inadvertent filing first the European application and the subsequent discovery of such inadvertent European filing.

Mr. Burkhart checked the initial (priority) patent application filings through the Patent department of Alcan Technology & Management Ltd. since 2000, the year the Patent department had the last priority filing in the U.S. He counted a total of about 109 original filings, that is, 75 in Europe, 24 in Germany, and 7 in Switzerland (all in the German language) plus, one filing in the U.K., done by an outside U.K. Counsel, and one filing in the U.S. going back to the year 2000 as aforementioned.

On December 5, 2003 Mr. Marsh sent an e-mail to Mr. Burkhart and Ms. von Rohr requesting further information concerning the declaration and petition. On December 5, 2003 Mr. Marsh received an e-mail from Ms. von Rohr on behalf of Mr. Burkhart and herself that set out the requested additional information. On December 7, 2003 Mr. Marsh sent an e-mail to Ms. von Rohr requesting certain further information. On December 8, 2003 Mr. Marsh sent an e-mail to Mr. Wittemer requesting specific information and on the same date Mr. Wittemer sent the requested information to Mr. Marsh. On December 9, 2003 Mr. Marsh received an e-mail from Ms. von Rohr setting out the requested information. On December 9, 2003 Mr. Marsh sent by e-mail and fax proposed declarations to Mr. Burkhart, Mr. Wittemer, Mr. Gernet and Ms. von Rohr for their review. On December 10, 2003 Mr. Wittemer sent his executed declaration to Mr. Marsh. On December 12, 2003 Mr. Burkhart sent the executed declarations of Mr. gernet, Ms. von Rohr and himself to Mr. Marsh by fax and air carrier. (Mr. Marsh's fax machine malfunctioned so that all of such faxed documents were not

received.) Such executed declarations were received by Mr. Marsh's office on December 15, 2003.

The enclosed declarations (and the above summary) show that foreign filing was done through error without deceptive intent, and set out the circumstances surrounding the diligence and make a showing that the license was diligently sought after discovery of foreign filing.

It is respectfully requested that this petition for a retroactive license for foreign filing be granted.

Respectfully submitted,

Date: Dec. 23, 2003



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